

**REMARKS**

In the Final Office Action mailed February 10, 2004, Claims 1 – 5, 11 – 17, and 19 – 24 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pat. Publ. No. 2002/0087461 (“Ganesan”) in view of U.S. Pat. Publ. No. 2001/0037247 (“Haseltine”). The rejections are respectfully traversed.

A *prima facie* case under §103 requires, *inter alia*, that all of the claim limitations be taught or suggested by the cited references and that there be a motivation to combine the reference teachings as proposed.

First, at least the following claim limitation from independent Claim 1 is not taught or suggested by either of the cited references, nor are the corresponding limitations from the independent apparatus claims, Claims 13 and 23 : “recording, by the provider computer over a communications link between the provider computer and an input device at one of the plurality of provider offices, confirmation of noncredit collection of the cost *from the customer at the one of the plurality of provider offices in accordance with the communication*” (emphasis added). In particular, neither Ganesan nor Haseltine teaches or suggests collection of a cost for a sale-of-goods transaction at one of a plurality of geographically distributed provider offices. Indeed, both Ganesan and Haseltine teach away from such collection, a factor that strongly indicates that to modify either of those references in that way is *not* obvious.

Specifically, Ganesan teaches the use of an intermediary “processing agent” to provide an escrow in Internet (or other network) transactions (Ganesan, ¶ 40). A transaction for the sale of goods using the intermediary processing agent is similar to a conventional Internet-based transaction except that the purchaser is given an opportunity to select use of an escrow arrangement, such as by selecting a hyperlink on the seller’s web page (*id.*, ¶ 132). The escrow arrangement is coordinated by the intermediary processing agent. Notably, Ganesan teaches that that payment by the purchaser is performed by providing the processing agent with payment instructions that include the payment amount and identification information previously

established during an enrollment procedure (*id.*, ¶ 132). This payment information may be used by the processing agent to initiate debit and credit transactions for the purchaser and seller in accordance with the escrow conditions (*id.*, ¶ 133). In this way, Ganesan teaches specifically that payment for the transaction be made by the purchaser electronically, not at one of a plurality of geographically distributed provider offices as the claims require.

Haseltine similarly teaches against payment for a transaction by the customer at one of a plurality of geographically distributed provider offices. In the context of merchant transactions (described in Haseltine as transactions with “e-tailers”), Haseltine teaches that a mechanism be provided for the return of unsatisfactory merchandise after delivery (*see generally id.*, discussion of Fig. 1). For such e-tailer transactions, Haseltine teaches that “[p]ayment is customarily achieved by credit card” (*id.*, ¶ 27), and confirms that credit payments are also expected when its exchange-facility system is used between private parties (*id.*, ¶ 55). Nothing in Haseltine teaches or suggests collection of the cost of the transaction from the customer at one of the plurality of geographically distributed provider offices. While the Final Office Action notes that Haseltine discloses that the service provider may have a plurality of offices, the portion of Haseltine that is cited deals only with the mechanics involved in returning the goods after inspection by the customer (*id.*, ¶ 32). The “input device” noted in the Final Office Action is used for swiping bar-coded packing lists and is not involved with recording collection of the cost of the transaction by the customer.

Since neither of the cited references discloses the claim limitation, no *prima facie* case under §103 has been established.

Second, there is no motivation to combine Haseltine with Ganesan in the manner proposed in the Office Action. Such a motivation must be drawn from “the references themselves or ... the knowledge generally available to one of ordinary skill in the art.” MPEP 2143. In this instance, the Final Office Action offers only the following motivation, which amounts merely to a statement of advantages of the combination claimed by Applicants:

It would have been obvious to one of ordinary skill in the art at the time of the invention to link the provider computer (processing agent) link with a plurality of geographically distributed provider offices via a communication link and provide for recording of the confirmation of noncredit collection of the cost for the goods because this would allow the processing agent (escrow agent) to provide services to consumers without access to electronic payment and consumers located in diverse geographic locations.  
(Final Office Action, p. 4).

This statement points to nothing articulated in either of the references as suggesting the combination, and actually suggests a change in the principle of operation of Ganesan, a factor that has long been recognized as evidence that the proposed modification is *not* obvious. MPEP 2143.01. As noted above, Ganesan teaches specifically that the purchaser make payment by providing the processing agent with instructions that include the payment amount and identification information previously established during an enrollment procedure (*id.*, ¶ 132). To modify Ganesan to provide a plurality of geographically distributed provider offices in lieu of the computer processor described in connection with Figs. 11A and 11B of Ganesan (*see id.*, ¶¶ 105 – 109) would greatly increase the cost of operating the intermediary processing agent and would render the extensively described registration process (*see id.*, ¶¶ 110 – 130) irrelevant. Nothing in either of the cited references provides a motivation for such an extensive change in the principles under which processing agent of Ganesan operates.

The Final Office Action also notes parenthetically that “performing merchandise transactions and payments over a communication network linking a provider of services via a plurality of geographically distributed provider offices is old and well known,” citing an example of catalog ordering at retail outlets (Final Office Action, p. 3). This example does not recognize the context of Ganesan, however, which is directed to the use of the Internet as an alternative mechanism for purchasing goods that intentionally avoids aspects of brick-and-mortar transactions (*see* Ganesan, ¶ 9). If this parenthetical remark is intended to rely on Official Notice to provide a motivation for modifying Ganesan in the manner proposed, Applicant respectfully traverses such Official Notice and asks for a showing of documentary proof. MPEP 2144.03.

Appl. No. 09/965,667  
Amdt. dated March 4, 2004  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group

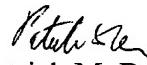
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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
Patrick M. Boucher  
Reg. No. 44,037

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
PMB:pmb  
60156990 v1